

REMARKS

I. Status of the Claims

The Examiner has withdrawn the election requirement of January 2, 2008. Claims 1-64 are pending. No claim is amended in this response.

II. Response to Arguments

Applicants respectfully acknowledge the Examiner's indication that previous rejection(s) of record has been withdrawn.

III. Double Patenting

Claims 1-64 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly "being unpatentable over claims 1-130 of U.S. Patent No. 681177" to Ferrari et al. ("*Ferrari*"). Office Action at 3. Conceding the conflicting claims are not identical, the Examiner alleges that "they are not patentably distinct from each other." Specifically, the Examiner states that "[t]he polymers dispersed in first phase, their amounts, the surface stabilizer, other excipients such as wax, gelling agents, the particle size of dispersed polymers and the compounds of the second composition described in the patented claims are also described in the instant claims and therefore the patented claims anticipate the instant composition, kit and the method of applying the composition." *Id.* Applicants disagree and respectfully traverse for at least the following reasons.

In double patenting, it is well established that the comparison must be done between the **claims** of an issued patent and the **claims** of a pending application. See MPEP § 804.03. As such, *Ferrari's* **claims** do not expressly teach or suggest including in

the second composition any polymers having an average molecular weight of greater than or equal to 200,000 g/mol, as presently claimed. The Examiner thus can only be relying upon a theory of inherency. But in doing so, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic (an average molecular weight of greater than or equal to 200,000 g/mol), necessarily and inevitably flows from the teachings of *Ferrari's* claims. However, most of the silicone-based and/or fluoro-based liquid phases as **claimed** in *Ferrari* have an average molecular weight of lower than 200,000 g/mol. For example, claim 48 of *Ferrari* recites that "the weight average molecular weight of the compound ranges from 500 to 100,000." As such, *Ferrari's* claims do not anticipate the instant composition, kit and the method of applying the composition.

As demonstrated above, *Ferrari's* claims do not expressly or inherently anticipate the current claims. Likewise, *Ferrari's* claims do not render the current claims obvious. *Ferrari's* claim 1 is silent with respect to the average molecular weight of the polymers in both compositions (coats), whereas the current claims specify an average molecular weight greater than or equal to 200,000 g/mol for the at least one high molecular weight polymer comprised in the second composition. Even though claim 21 of *Ferrari* recites that the **first** composition can further comprise a rheological agent comprises a lipophilic gelling agent selected from the group consisting of ethylene homopolymers and/or copolymers with a weight average molecular weight ranging from 500 to 500,000, it does not motivate or suggest a skilled artisan to incorporate and expand this molecular weight information into a polymer that is comprised in the **second** composition and can be a

silicon polymer (differs from ethylene homopolymer or copolymer) to arrive at the current claims. Thus, the current claims are non-obvious in view of *Ferrari*'s claims and the double patenting rejection over *Ferrari* should be withdrawn.

IV. Claim Rejections - 35 USC § 102

Claims 1-64 are also rejected under 35 U.S.C. § 102 (e) as allegedly "being anticipated by" U.S. Application Publication No. 2003/0039621 to Arnaud et al. ("*Arnaud*") or over U.S. Patent No. 6,811,770 to Ferrari et al. ("*Ferrari*"). Office Action at 3-6. Applicants disagree and respectfully traverse.

Arnaud teaches a cosmetic make-up product containing a first and a second composition, the first composition comprising, in a physiologically acceptable medium, dispersed polymer particles surface-stabilized with a stabilizer in a liquid organic phase and a coloring agent, and the second composition comprising a physically acceptable medium. *See* paragraph [0038]. *Arnaud* further teaches that the physically acceptable medium for the second composition preferably comprises a non-volatile liquid phase which may be a hydrocarbon-based phase, a silicone-based phase and/or a fluoro-based phase. *See* paragraphs [0153] and [0155]. *Arnaud* does not disclose molecular weight information on most of these phases in the second composition, let alone a "high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000g/mol", as recited in the present claims. On the contrary, *Arnaud* teaches that the fluoro polyethers have the weight-average molecular weight ranging from 500 to 100,000 and preferably from 500 to 10,000. *See* paragraph [0182].

Furthermore, none of the exemplary compounds for the second composition as disclosed by *Arnaud*, for example, the fluorosilicones sold by Shin-Etsu, *see* paragraph [0176], inherently has an average molecular weight of greater than or equal to 200,000 g/mol.

It appears as though the Examiner is contending, without saying as much, that *Arnaud's* first composition comprising dispersed polymer particles, preferably having a molecular weight ranging from 2,000 to 10,000,000, is representative of the second composition of the current claims, comprising at least one high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000 g/mol. However, under that logic, the Examiner thus must find the first composition of the current claims, comprising a liquid fatty phase and polymer particles dispersed in the liquid fatty phase, in *Arnaud's* teaching of his second composition. In reality, the second composition taught by *Arnaud* is just a physiologically acceptable medium preferably comprising a liquid phase. *See* paragraph [0151]-[0154]. *Arnaud* does not teach, inherently or explicitly, a second composition comprising the "polymer particles dispersed in the liquid fatty phase" as in the first composition of the current claims.

As such, *Arnaud* does not anticipate the present claims and the rejection over *Arnaud* should thus be withdrawn.

For the same reasons, *Ferrari* does not anticipate. *Ferrari* describes a cosmetic make-up composition comprising a first composition and a second composition, the first composition comprising, in a first physiologically acceptable medium, dispersed polymer particles surface-stabilized with a stabilizer in a liquid phase, and the second composition comprising, in a second physiologically acceptable medium, a silicone-based and/or

fluoro-based liquid phase. See col. 3, lines 9-19. Similar to *Arnaud*, *Ferrari* is silent on the molecular weight of most of the disclosed silicone-based and/or fluoro-based compounds in the second compositions, and only discloses that the fluoro compounds have the weight-average molecular weight ranging from 500 to 100,000 and preferably from 500 to 10,000, which does not anticipate the present claims. See col. 17, lines 47-49. Moreover, none of the exemplary silicone compounds or fluoro compounds inherently has an average molecular weight of greater than or equal to 200,000 g/mol. The Examiner's allegation that "[t]he composition of 6811770 also employs the instant claimed first and second compositions" is thus mistaken. Similar to the *Arnaud* rejection discussed above, switching the order of the first and second compositions taught by *Ferrari* will not lead to the claimed cosmetic product. The anticipation rejection over *Ferrari* should thus be withdrawn.

CONCLUSION

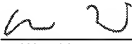
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims. If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (650) 849-6649.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 30, 2009

By:  _____
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